

Appl. No. 09/522,325
Amdt. Dated August 14, 2006
Reply to Office Action of April 14, 2006

REMARKS/ARGUMENTS

Claims 1-120 are pending in the present application.

This Amendment is in response to the Office Action mailed April 14, 2006. In the Office Action, the Examiner rejected claims 1-5, 7, 10-15, 17, 21-32, 54-60, 61-65, 67, 71-75, 77, 81-85, 87, 91-95, 97, 101-105, 107, and 111-115 under 35 U.S.C. §102(c); and claims 6, 8, 9, 16, 18-20, 66, 8-70, 76, 78-80, 86, 88-90, 96, 98-100 106, 108-110, 116, and 108-110 under 35 U.S.C. §103(a). Applicant has amended claims 54 and 57. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-5, 7, 10-15, 17, 61-65, 67, 71-75, 77, 81-85, 87, 91-95, 97, 101-105, 107, and 111-115 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,169,895 issued to Buhrmann et al. ("Buhrmann"); claims 21-32, and 54-60 under 35 U.S.C. §102(c) as being anticipated by U.S. Patent No. 6,603,977 issued to Walsh et al. ("Walsh"). Applicant respectfully traverses the rejection and contends that the Examiner has not met the burden of establishing a prima facie case of anticipation.

1. Claims 1-5, 7, 10-15, 17, 21-32, 54-60, 61-65, 67, 71-75, 77, 81-85, 87, 91-95, 97, 101-105, 107, and 111-115:

Buhrmann discloses a landline-supported private base station for collecting data and switchable into a cellular network. When an incoming call is directed to a particular mobile station, the private base station detects the ring and sends an alerting signal to the registered mobile station (Buhrmann, col. 6, lines 19-21, 28-30). A RF circuit performs the radio frequency signal processing (Buhrmann, col. 7, lines 21-23). An RF codec performs analog-to-digital and digital-to-analog conversions of the I and Q signals in the RF circuit (Buhrmann, col. 7, lines 21-23).

Buhrmann does not disclose, either expressly or inherently, at least one of: (1) a decoder to decode an activation message, the activation message being sent from an activator via a communication medium in response to a telephony call, the decoder generating an activation command; (2) a transmitting unit coupled to the decoder to transmit a signal modulated from an information message to a receiver using a communication protocol, in response to the activation

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command, as recited in claims 1, 81, and 101; or (1) a decoder to decode an activation message, the activation message being sent from an activator in response to a telephony call, the decoder generating an activation command; and (2) a receiving unit coupled to the decoder to receive a signal containing an information message responsive to the activation command, the information message being sent from a transmitter according to a communication protocol via a communication medium, as recited in claims 11, 91, and 111; or (1) decoding an activation message to generate an activation command, the activation message being sent from an activator via a communication medium in response to a telephony call; and (2) transmitting a signal modulated from an information message responsive to the activation command, by a transmitting unit, to a receiver using a communication protocol, as recited in claim 61; or (1) decoding an activation message to generate an activation command, the activation message being sent from an activator in response to a telephone call; and (2) receiving a signal containing an information message responsive to the activation command, the signal being sent from a transmitter according to a communication protocol, as recited in claim 71.

Buhrmann merely discloses a codec to perform A/D and D/A conversions and modulation for the transmission path (Buhrmann, col. 7, lines 33-38), not a decoder to decode an activation message. Performing A/D and D/A conversions only involve transformation the signal from one domain (e.g., analog) to another domain (e.g., digital). In addition, the I and Q signals of which the conversions are performed are not related to an activation message. They merely represent the RF signal from the mobile stations (Buhrmann, col. 7, lines 21-32).

Furthermore, Buhrmann merely discloses detecting the ring for an incoming call when an incoming call is directed to a particular mobile station (Buhrmann, col. 6, lines 19-21, lines 28-35), not sending an activation message in response to a telephony call. The private base station merely sends an alerting signal to the mobile station (Buhrmann, col. 7, lines 28-30). In other words, it acts like a switch to connect an incoming call to the mobile station. It does not perform sending any message to a decoder.

Moreover, Buhrmann merely discloses the RF unit to produce the I and Q signals for an RF codec (Buhrmann, col. 7, lines 21-32), or to perform modulation for the transmission path (Buhrmann, col. 7, lines 37-38), transmitting a signal modulated from an information message responsive to the activation command. Performing modulation merely modulates a signal

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according to some communication scheme. It does not involve an information message. Furthermore, it does not modulate the signal in response to an activation command. The Examiner recites the connection between the microprocessor 24 and the item 26 in Fig. 2 (Office Action, page 3). However, this connection merely shows the detection of the ring. It does not show the activation command and the information message.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Vergoogal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). Since the Examiner failed to show that Buhrmann teaches or discloses any one of the above elements, the rejection under 35 U.S.C. §102 is improper.

2. Claims 21-32, and 54-60:

Walsh discloses a location information system for a wireless communication device and method therefor. The location information represents locations of predetermined areas, such as floors, rooms, hallway, etc. (Walsh, col. 8, lines 38-40). In an E911 application, the wireless communication unit sends the location information at least one of before, during, and after the wireless communication device communicates an emergency telephone call to a public safety answering point (Walsh, col. 11, lines 42-46).

Walsh does not disclose, either expressly or inherently, at least one of: (1) A network comprising a plurality of commonly coupled location transmitters, each transmitter comprising a transmission unit to broadcast a signal modulated from an information message containing respective location information in response to a telephony call, as recited in claim 21; or (1) a receiver for receiving location information in response to a telephony call; (2) a processor for processing the location information; and (3) a network interface for transmitting the location information over a network, as recited in claims 54 and 57; or (1) a location sensor to provide location information in response to a telephony call; (2) a determination unit coupled to the sensor, the determination unit to determine the location information; and (3) a network interface

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coupled to the determination unit to selectively transmit the location information over a network, as recited in claim 60.

Walsh merely discloses the location information associated with a plurality of predetermined areas in the facility such as a floor, a room, etc. (Walsh, col. 10, lines 42-44, lines 54-59), not the respective location information, i.e., the location information of the transmitters.

Furthermore, Walsh merely discloses the wireless communication unit sends the location information at least one of before, during, and after the wireless communication device communicates an emergency telephone call to a public safety answering point (Walsh, col. 11, lines 42-46), not receiving location information transmitted by at least a transmitter in response to a telephony call. The location information may be sent before, during, or after the device communicates with an answering point regarding an emergency telephone call. To clarify this aspect of the invention, claims 54 and 57 have been amended.

Moreover, Walsh merely discloses a controller to receive location information from a location entry device (Walsh, col. 10, lines 42-45), not in response to a telephony call. The location entry device provides pre-determined location information such as manually by a keyboard or voice recognition program, or from a database, or by a GPS receiver (Walsh, col. 11, lines 23-34). Therefore, the location information is merely provided in advance in an off-line manner, not in response to a telephony call.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Vergegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). Since the Examiner failed to show that Walsh teaches or discloses any one of the above elements, the rejection under 35 U.S.C. §102 is improper.

Therefore, Applicant believes that independent claims 1, 11, 21, 38, 54, 57, 60, 61, 71, 81, 91, 101, and 111 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejections under 35 U.S.C. §102(c) be withdrawn.

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Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 6, 16, 66, 76, 86, 96, 106, and 116 under 35 U.S.C. §103(a) as being unpatentable over Buhrmann; claims 8, 9, 18- 20, 68-70, 78-80, 88-90, 98-100, 108-110, and 118-120 under 35 U.S.C. §103(a) as being unpatentable over Buhrmann in view of Walsh; claims 33-53 under 35 U.S.C. §103(a) as being unpatentable over Walsh in view of U.S. Patent No. 5,737,328 issued to Norman et al. ("Norman") Applicant respectfully traverses the rejection and contends that the Examiner has not met the burden of establishing a prima facie case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP §2143, p. 2100-129 (8th Ed., Rev. 2, May 2004)*. Applicants respectfully contend that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

1. Claims 6, 16, 66, 76, 86, 96, 106, and 116:

Buhrmann discloses a landline-supported private base station for collecting data and switchable into a cellular network as discussed above.

The Examiner admits that Buhrmann does not disclose the modulating scheme uses a pseudo random binary sound (PRBS), but takes official notice that such feature is well known in the art (Office Action, page 9, first paragraph). Applicant contends that such an official notice is inappropriate.

Official notice unsupported by documenting evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970); MPEP 2144.03A. It would not be appropriate for the Examiner to take official notice of facts without citing a prior art references. MPEP 2144.03A. Furthermore, if official notice is taken of a fact, unsupported by documentary

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evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable. MPEP 2144.03B.

Here, Buhrmann does not disclose discloses or suggests the use of the PRBS modulating scheme. The Examiner did not provide any reference regarding the PRBS modulating scheme and did not a technical line of reasoning which must be clear and unmistakable. Accordingly, the rejection is improper.

2. Claims 8, 9, 18-20, 68-70, 78-80, 88-90, 98-100, 108-110, and 118-120:

Buhrmann discloses a landline-supported private base station for collecting data and switchable into a cellular network as discussed above. Walsh discloses a location information system for a wireless communication device and method therefor as discussed above.

Since Buhrmann does not disclose or suggest the location identifier including the GPS information, any combination of Buhrmann with any other references is improper.

Furthermore, Walsh merely discloses location technology is added to the current cell sites to calculate a caller's latitude and longitude (Walsh, col. 4, lines 48-50). A GPS receiver receives latitude and longitude data from 24 GPS satellites (Walsh, col. 4, lines 55-57). The location information is not transmitted in response to an activation command or a telephony call.

3. Claims 33-53:

Walsh discloses a location information system for a wireless communication device and method therefor as discussed above.

Norman discloses a network communication system with information rerouting capabilities. Access points provide wireless access to the system reroute misrouted information packets in the event the location of a mobile unit has changed (Norman, col. 3, lines 52-55). A "current location" table is maintained in the memory of each access point to keep track of when mobile units are currently located (Norman, col. 3, lines 64-66).

As discussed above, Walsh merely discloses a controller to receive location information from a location entry device (Walsh, col. 10, lines 42-45), not in response to a location information request. In addition, Walsh does not disclose a network interface to externally issue the respective location. Accordingly, a combination of Walsh with any other references in rejecting claims 33-52 is improper.

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Furthermore, Norman merely discloses the location information representing the route from the access point to the respective access point to which the mobile unit is registered (Norman, col. 11, lines 38-40). The route is not a location information because it only shows the source and destination (Norman, col. 11, lines 36-37).

In summary, Buhrmann, Walsh and Norman, taken alone or in any combination, do not disclose, suggest, or render obvious the above elements. There is no motivation to combine Buhrmann, Walsh and Norman because none of them addresses the problem of automatic remote communication using network telephony. There is no teaching or suggestion that an activation being sent in response to a telephony call is present. Buhrmann or Walsh, read as a whole, does not suggest the desirability of receiving location information transmitted by a transmitter in response to a telephony call. For the above reasons, the rejections under 35 U.S.C. §103(a) are improperly made.

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). "When determining the patentability of a claimed invention which combined two known elements, 'the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. Interconnect Planning Corp. v. Feil, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed

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invention, would select the prior elements from the cited prior references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." In re Mills 916 F.2d at 682, 16 USPQ2d at 1432; In re Fitch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

In the present invention, the cited references do not expressly or implicitly suggest any of the above elements. In addition, the Examiner failed to present a convincing line of reasoning as to why a combination of Buhrmann, Walsh and Norman is an obvious application of automatic remote communication using network telephony.

Therefore, Applicant believes that independent claims 1, 11, 21, 38, 54, 57, 60, 61, 71, 81, 91, 101, and 111 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §103(a) be withdrawn.

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Conclusion

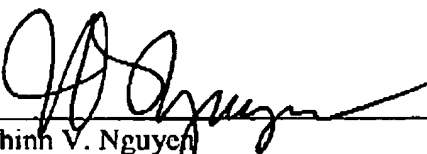
Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: August 14, 2006

By


Thinh V. Nguyen
Reg. No. 42,034
Tel.: (714) 557-3800 (Pacific Coast)

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025

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